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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,747	08/29/2006	Marc Seidel	6097.P077	2599
8791 7590 06/04/2010 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER				
BUCKLE JR, JAMES J				
ART UNIT		PAPER NUMBER		
3633				
MAIL DATE		DELIVERY MODE		
06/04/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/565,747

**Applicant(s)**

SEIDEL, MARC

**Examiner**

JAMES J. BUCKLE JR

**Art Unit**

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The following is a Final office action in response to communications received on 3/16/2010. Claims 1 and 7 have been amended. Claim 4 has been canceled. Currently, claims 1-3, and 5-17 are pending and examined below.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3 and 5-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants recitation of the first type of anchoring elements having an enlarged free end portion with **a diameter or length greater than or substantially equal to the distance from the free end portion to the wall** of the second tower segment in claim 1 is neither supported in the written specification or in the Drawings. The Drawings are not to scale therefore the drawings provide inadequate support for this limitation. The claims are examined as best understood.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-3 and 5-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Ramm et al (U.S. Patent No. 5, 426, 903).
6. Regarding claims 1 and 13, AAPA discloses a tower (Fig. 5, Page 2, lines 19-29), for a wind energy turbine, comprising a first tower segment (1) having a wall comprising concrete material and a second tower segment (3) having a wall comprising steel, wherein the wall of the second tower segment comprises an end portion embedded in an embedment portion of the wall of the first tower segment, and wherein the second tower segment within its embedded end portion comprises a separate anchoring element (6) projecting radially inward from a least one of the side surfaces of the wall of the second tower segment as well as the outer surface, arranged along an axial direction of the second tower segment to prevent internal force concentrations within the wall of the first tower segment. The Examiner considers the weld attached to the inner and outer surfaces connecting the anchoring element to sufficiently meet the limitation of being fixedly mounted to the inner and outer surfaces of the wall of the second tower segment. AAPA does not disclose a plurality of anchoring elements being fixedly mounted to at least one of the side surfaces of the wall of the second tower segment. However, Ramm et al. teaches that it is known to have metal weld-on dowels for

steel/concrete composite construction (Fig. 8) to achieve composite action and increase the bond between concrete and steel. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the second tower segment disclosed by AAPA to have a tower segment with a plurality of dowels as anchor elements mounted on at least one of the side surfaces of the wall to achieve composite action and increase the bond between concrete and steel. Further, the use of a plurality of these dowels will greatly increase the pull out strength of the metal tower section from the concrete section. AAPA and Ramm teaches the plurality of anchoring elements comprising a first and second type of anchoring elements. The first type having a enlarged free end portion and the second type having annular portions that are contact with the bottom and both surfaces of the wall. AAPA and Ramm do not teach the first type having a free end poriotn having a diameter or length greater than or substantially equal to the distance from the free end portion to the wall of the second tower. However, Ramm et al. teaches that enlarging the free end would further ensure a good anchoring of the dowel in the concrete. It would have been an obvious design choice to one having ordinary skill in the art to have modified the dowel to have a larger free end that could be equal or greater to the distance of the shank to secure the dowel in the concrete (Col. 3, lines 65-68).

7. Regarding claims 2 and 3, AAPA further discloses the first and second tower segment as being tubular (Page 2, lines 19-29).

8. Regarding claims 5-7 and 14-17, AAPA in view of Ramm et al. discloses a tower as set forth above with a plurality of anchoring elements comprising the first type of

anchoring elements comprising a headed stud with an enlarged free end (5, Ramm et al.) having a free end portion opposite to the wall of the second tower segment and a second type of anchoring element having at least sections of annular portion comprising the first type of anchoring elements, but does not disclose the first or second type having end portions extending along the circumferential direction. However, AAPA discloses the anchoring element (6) that is of ring-like configuration to be able to sufficiently produce a composite construction. Therefore, it would be obvious to provide the plurality of anchoring elements extending contiguously in a circumferential direction to produce a composite construction. There would be no new or unpredictable results achieved from provide the surface area of both sides of the tower wall with a sufficient amount of anchoring elements to produce a composite construction.

9. Regarding claim 8, AAPA in view of Ramm et al. discloses the plurality of anchoring being welded to the wall of the second tower segment (Abstract; Ramm et al.).

10. Regarding claim 9, AAPA further discloses the wall of the first tower segment further comprising a reinforcement element (5) in at least its embedded end portion.

11. Regarding claim 10, AAPA further disclosed the wall of the first tower segment comprising pre-stressed concrete (1) in at least its embedded end portion.

12. Regarding claim 11, AAPA further discloses the wall of the first tower segment comprising a plurality of pre-stressing elements (2, Fig. 4) axially extending through at least the embedment portion and arranged so as to face the inner surface or the outer surface of the embedded end portion of the second tower segment. It would have been

obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the plurality of pre-stressing elements disclosed in Fig. 4 in the tower disclosed in Fig. 5 to increase the tensile strength of a tower. There would be no new or unpredictable results achieved by incorporating pre-stressing elements in a steel and concrete composite structure..

13. Regarding claim 12, AAPA in view of Ramm et al. discloses the plurality of anchoring elements arranged at the surface of the embedded end portion of the wall to the second tower segment that would be adjacent to the pre-stressing elements of the first tower segment.

#### ***Response to Arguments***

14. Applicant's arguments filed 3/16/2010 have been fully considered but they are not persuasive. Applicant argues that, (1) AAPA and Ramm et al (U.S. Patent No. 5,426,903) alone or in combination fails to teach a plurality of anchoring elements consisting of two types of anchoring elements, the first type having an enlarged head with a diameter or length greater than or substantially equal to a distance from the free end portion to the wall and a second type that is only in contact with either one of the side surfaces of the wall, (2) and that the combination would be impermissible hindsight.

15. In response argument (1), Examiner respectfully disagrees. As best understood AAPA in view of Ramm et al. discloses the first type having an enlarged head that can be larger than the length to ensure good anchoring and a second type of anchoring that is considered to be in contact with the bottom and both side surfaces of the wall as set

forth above. Therefore, the examiner maintains that the combination teaches the claimed invention.

16. In response to argument (2), Examiner respectfully disagrees. Applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Furthermore, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, it is known to have metal weld-on dowels for steel/concrete composite construction (Fig. 8) to achieve composite action and increase the bond between concrete and steel.



**Conclusion**

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JAMES J. BUCKLE JR** whose telephone number is (571)270-3739. The examiner can normally be reached on Monday-Thursday, Alternating Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Dunn can be reached on 571-272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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